

O-083-19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. 3266023 AND 3266031

BY BIG BUS TOURS LIMITED TO REGISTER:



(SERIES OF TWO)

AND

HOP-ON DISCOVER HOP-OFF EXPLORE

AS TRADE MARKS IN CLASS 39

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO

UNDER NOS. 411631 AND 411632 BY JULIA TRAVEL, S.A.

Background & Pleadings

1. On 30 September 2016, Big Bus Tours Limited (“the applicant”) applied to register each of the above trade marks for the following services in Class 39:

Provision of bus tours; sightseeing services; provision and arranging of tours; provision of tourist information and advisory services relating to travel and sightseeing; rental of buses, including for film shoots and promotional videos.

The applications were published for opposition purposes on 10 November 2017.

2. On 12 February 2018, both applications were opposed in full by JULIA TRAVEL, S.L. (“the opponent”)¹. The oppositions are based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the following trade mark:

European Union Trade Mark (“EUTM”) 9529363:



Filing date: 17 November 2010

Registration date: 10 May 2011

The opponent indicates that it intends to rely upon all services for which its mark is registered, all of which are proper to Class 39, namely:

Transportation of passengers; Booking of seats for travel; Travel arrangement; Arranging of cruises; Tour operating; Tourist offices (except reservation of hotels and boarding houses); Sightseeing services; Escorting of travellers; Advice on tourist

¹ At the time of opposition, the opponent’s name was JULIA TRAVEL, S.A.. It has since changed its name to JULIA TRAVEL, S.L.. It has filed evidence to that effect and updated the register accordingly.

visits; Information on transport; Franchise-issuing relating to the transport, packaging and storage of goods; Vehicle rental of all kinds with or without chauffeur.

3. The opponent submits, inter alia, that both applied for marks are visually, conceptually and phonetically similar to its EUTM and that the competing services are at least highly similar, if not identical.

4. In its counterstatements, the applicant denies that the respective marks are similar overall and denies that there is a risk of confusion and/or association.

5. The applicant in these proceedings is represented by Carpmaels & Ransford LLP and the opponent by Lane IP Limited. Both parties filed evidence. Alongside its evidence, the applicant filed written submissions entitled 'observations in reply', which were supported by six annexes. The annexes are in fact exhibits which have not been adduced by way of a witness statement. Consequently, they cannot be formally accepted as evidence and I have considered them only to the extent that they contain submissions. Neither party requested a hearing; only the opponent filed written submissions in lieu. This decision is taken following a careful reading of all the papers which I will refer to, as necessary.

Decision

6. The oppositions are based upon section 5(2)(b) of the Act which reads as follows:

“5 (2) A trade mark shall not be registered if because –

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. Given its filing date, the opponent’s trade mark qualifies as an earlier mark under the above provisions. In accordance with section 6A of the Act, as the mark completed its registration procedure more than five years prior to the publication date of the applicant’s mark, it is subject to the proof of use provisions. In both Notices of Opposition, the opponent indicated that it had used its earlier mark in respect of all services relied upon in these proceedings. In its counterstatements, the applicant requested that the opponent provide evidence to support this claim.

9. Under section 6A, the relevant period is the five-year period ending on the date that the opposed mark was published. For the purposes of this opposition, the relevant period is, consequently, 11 November 2012 until 10 November 2017.

Evidence summary

Opponent’s evidence

10. The opponent’s evidence comprises a witness statement by Ms Sonia Adell, dated 12 June 2018, and seven supporting exhibits. Ms Adell is the opponent’s Director of the Legal and Human Resources Department. The following information can be gleaned from her statement:

- The opponent provides guides and tours on buses in cities throughout Europe, including London, Madrid, Barcelona, Granada and Rome;
- Its subsidiary UK company, London City Tour Limited (“LCTL”) began operation of tourist buses around London on or around 23 March 2015. Its tours are offered in a variety of languages. It provides 18 buses during the week and 20-22 on the weekends;
- Annual passengers for the London tours totalled approximately 111,000 in 2016 and 137,000 in 2017;
- Gross sales accrued in respect of the opponent’s London bus tours were €2,424,000 in 2016 and €3,300,000 in 2017²;
- Marketing and advertising expenditure made in respect of the London city bus tour amounted to £151,115 in 2016 and £223,442 in 2017³. The opponent produces approximately 150,000 promotional brochures each year in respect of its bus tours and services.

11. Exhibit 1 comprises a print-out from the *london.city-tour.com* website and pages retrieved from the opponent’s company website, *Grupo Julià*. Neither are dated. The former confirms that the available services are operated by London City Tour Ltd., a subsidiary of the Julià Group which, it states, is a family business operating in the tourism and transport sectors. It also states that the opponent is the third largest tourist bus operator in the world and began operation of City Tours over 15 years ago, though given that the page is undated, it is not clear when these details were accurate. The headings available to site visitors are ‘ATTRACTION PASS’, ‘TRIP PLANNER’, ‘BUS PACKAGES’, ‘ITINERARIES CITY TOUR’, ‘WHAT TO SEE?’, ‘FEATURED MONUMENTS’ and ‘FAQ’S’. The page provides an order facility encouraging customers to ‘BUY YOUR TICKET NOW’, offering a special online rate. The purchase is pre-set to ‘Tourist bus panoramic’ but other ticket options appear to be available for selection using a drop-down box.

12. The latter pages, from the opponent’s group site, offer an insight into the services provided, with links offering customers additional information specifically in relation to

² Neither amount was converted from Euros to GBP in Ms Adell’s statement

³ Ms Adell provides the total expenditure in Euros only (€265,442)

City Tour and *Gourmet Bus* ('a tour of the city dining experience'). A brief overview of the *City Tour* service suggests that it is "the best way to see a city from a different perspective from its tour buses and trains". It lists the locations in which *City Tour* is available, some of which are outside of the European Union (EU). Those within the EU are Barcelona, Benidorm, Fuengirola, Girona, Granada, London, Madrid, Murcia, Peñíscola, San Sebastián and Toledo. Pictures of the buses are included. I am unable to identify the opponent's mark as registered, or the words of which it is comprised, displayed on any of the pages within Exhibit 1.

13. Exhibit 2 consists of two copies of the same web page, headed 'City Tour London'⁴; one in Spanish and one in English. It is my understanding from Ms Adell's statement that the Spanish version is intended to demonstrate that the opponent's services target a variety of tourists throughout Europe; not only those who are English-speakers. There are several flags listed in the corner of the website to denote the language under which the tours and audio descriptions are available. Audio guides providing information at each stop along the given route are available in ten languages, namely English, Spanish, French, German, Italian, Russian, Hindi, Chinese, Japanese and Portuguese. London City Tour is described as a fleet of 24 double decker buses. Once aboard, passengers are presented with an information brochure containing a map of London and detailed information regarding the stops along the route. The brochure is available in five languages, namely English, Spanish, French, German and Japanese. The site indicates that a free mobile application is available for download, to ensure the pertinent information regarding the London City Tour is accessible to customers at all times. The earlier mark is displayed on both pages alongside a description of the services on offer. It is not clear on which date the web pages were retrieved, nor when the services were available to purchase.

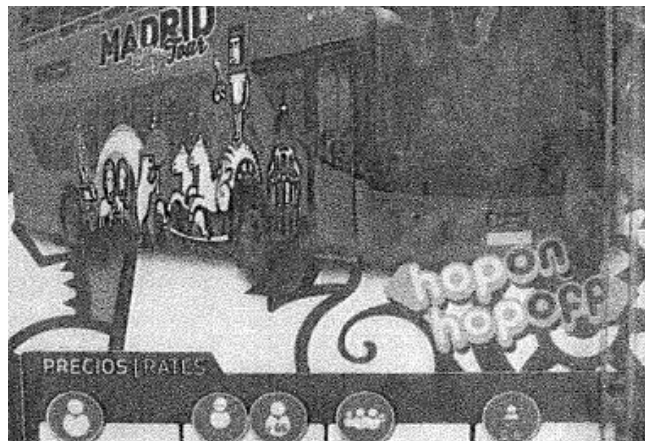
14. Exhibit 3 comprises a selection of archived web pages from the opponent's *london.city-tour.com* site, with dates ranging from 24 February 2016 to 21 November 2016. The opponent's mark can, again, clearly be seen on each of the pages alongside various extracts detailing the available services, as seen below:

⁴ The URL is not visible



15. At Exhibit 4, the opponent provides archived web pages relating to its City Tour services available outside of the UK, specifically in Madrid⁵ (dated 26 March 2016), Rome⁶ (dated 4 January 2017), San Sebastián⁷ (dated 4 July 2017), Granada⁸ (dated 26 August 2016) and Barcelona⁹ (dated 25 February 2016). With the exception of San Sebastián, the opponent’s mark is displayed in its entirety alongside the relevant service details. On the San Sebastián site, the opponent submits that its mark is shown in a photograph of a bus, on the bus itself, but without the final word ‘ALLIANCE’, though this is difficult to verify based solely on the quality of the exhibit

16. Exhibit 5 provides a photograph of one of the opponent’s buses and a photograph of a poster which the opponent explains was on display at a Madrid bus stop, though it does not clarify precisely when. In both photographs, the opponent’s mark is displayed without the word ‘ALLIANCE’. Extracts from each can be seen below:



⁵ <http://madrid.city-tour.com:80/en/our-buses>

⁶ <http://roma.city-tour.com/en>

⁷ <http://sansebastiancity-tour.com:80/en>

⁸ <http://granada.city-tour.com:80/en>

⁹ <http://barcelona.city-tour.com:80/en/our-buses>

17. The first three pages of Exhibit 6 are undated print-outs taken from the *london.city-tour.com/en* website and provide an insight into the various packages available to purchase. *TOURIST BUS PANORAMIC*, for example, is available to purchase from £21.60 and *GOLDEN PACKAGE – 48H TICKET* is priced from £51.00. The remaining pages are extracted from the LCTL 2016 financial report. The report shows, inter alia, that the company's turnover in 2015 was £1,052,797 and £2,147,629 in 2016. Given that the report appears to relate solely to the London subsidiary, the figures are presumably reflective of the opponent's UK sales only and not inclusive of the opponent's wider EU turnover.

18. Exhibit 7 comprises two articles, both of which appear to have been published on the opponent's *Grupo Julià* website. The first is dated 11 July 2017 and is headed "Grupo Julia closes 2016 with sales of more than €309m and the creation of 70 new job positions". Ms Adell directs me to the following extract from the article:

"By divisions, the one that presents a greater increase is the City Tour, the tourist buses and trains, which has risen 17% respect to the previous year with an invoicing of €60m. With more than 4 million passengers in 2016, during the last few years City Tour has become one of the main tourist bus operators in the world."

19. The second article is dated 6 April 2016 and is headed "Grupo Julià closes 2015 hitting a sales record of 301 million euro". Ms Adell highlights the following passage:

"City Tour bus and train division has greatly grown in 2015 rising by 19.4% and reaching 51.7 million euro, motivated by new London City Tour service and by the good progress of the San Francisco and Washington tourist bus services. In fact, in the last few years, the company has been declared one of the three main international tourist bus operators with more than 3.7 million passengers in 2015. Nowadays, City Tour brand can be found in 18 international capitals with around 200 vehicles."

Applicant's evidence

20. The applicant's evidence comprises a witness statement from its Executive Vice President of Marketing and E-Commerce, Mr Andrew Furlong, and supporting exhibits AF1 to AF7. In his statement, Mr Furlong asserts that 'hop-on-hop-off' is a generic term used within the travel and tourism industry "to describe tours where customers are free to get on and off one or multiple vehicles to explore sights and areas along a designated route."¹⁰ In addition to the numerous exhibits filed to support this claim, his statement refers specifically to a global survey commissioned by Big Bus Tours in 2017 to measure customers' brand awareness, the results of which revealed that 40% of customers in London, Paris and New York could not identify the company from which they were purchasing their 'hop-on-hop-off' tour.

21. At Exhibit AF1, the applicant provides what it refers to as a 'background' to the term 'hop-on-hop-off', beginning with an undated extract from the Travel Industry Dictionary¹¹, describing 'hop-on-hop-off' as:

A type of tourist bus or tram that follows a circular route with fixed stops through a city and that allows paying passengers unlimited travel for a day (or other period of time) with the freedom to disembark at any stop and reboard another bus or tram to continue their journey.

22. The exhibit's subsequent pages are taken from the *Backpacker Guide.NZ* website. Under its 'Travel Tips' section, the site poses the question 'What is a Hop-on Hop-off bus?'. It provides users with useful information and relevant web links and describes 'hop-on hop-off' as a backpacker bus network in New Zealand seeking to provide customer flexibility. It states that there are several bus companies operating in New Zealand under this premise and offers guidance on how to use such transportation. The pages are undated.

23. The final pages of AF1 comprise an online Forbes article¹² dated 20 July 2018 titled 'The 10 Best Hop-On Hop-Off Tours In The World'. It begins:

¹⁰ See paragraph 7 of the witness statement of Mr Andrew Furlong

¹¹ <http://www.travel-industry-dictionary.com/hop-on-hop-off.html>

¹² <https://www.forbes.com/sites/nomanazish/2018/07/20/the-10-best-hop-on-hop-off-tours-in-the-world/#5b1f6e62518a>

“Exploring the city atop a **hop-on hop-off bus** is a unique experience.”

(my emphasis)

The article provides a brief explanation of the ten highest ranked worldwide ‘hop-on hop-off’ tours, according to the TripAdvisor Travellers’ Choice Awards. Below is a summary of the results:

1. *Barcelona Hop-On Hop-Off Tour: East To West Route (Spain)*
2. *The Original London Sightseeing Tour Hop-On Hop-Off (UK)*
3. *Washington DC Hop-On Hop-Off Trolley (USA)*
4. *Sydney And Bondi Hop-On Hop-Off Tour (Australia)*
5. *Madrid Hop-On Hop-Off Tour (Spain)*
6. *Boston Hop-On Hop-Off Trolley Tour (USA)*
7. *City Sightseeing Dublin Hop-On Hop-Off Tour (Ireland)*
8. *Florence City Hop-On Hop-Off Tour (Italy)*
9. *City Sightseeing Singapore Hop-On Hop-Off Tour (Singapore)*
10. *Big Bus Paris Hop-On Hop-Off Tour (France)*

24. At Exhibit AF2, the opponent encloses the results generated by Google from the respective searches “What is a hop-on-hop-off tour” and “hop-on-hop-off tours”. Listed amongst the results are a selection of companies, based in various locations but primarily in London, offering what they describe as a “hop-on hop-off” bus service. Mr Furlong has not clarified when the results were retrieved but submits that this is indicative of a saturated market and shows that there are numerous operators providing tours of this description.

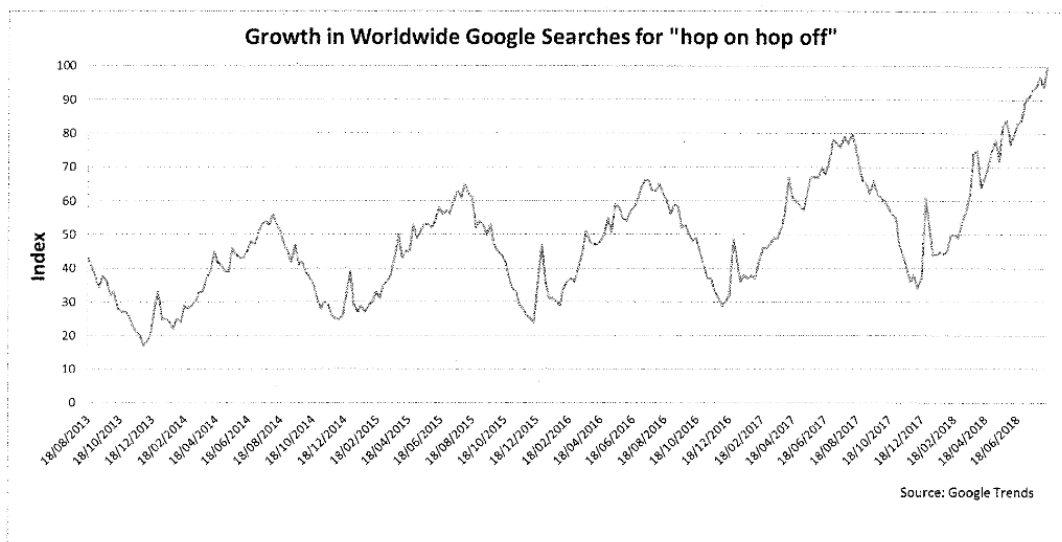
25. To further illustrate the UK position, Mr Furlong provides an additional Google search result at Exhibit AF3, specifically for “UK hop-on-hop-off tours”. A variety of tour operators is displayed, all London based and all referring to a service described as ‘hop-on hop-off’.

26. The search is narrowed further at Exhibit AF4, to “London hop-on-hop-off”. Again, a variety of operators are listed, many of which duplicate those shown in the UK

search. The exhibit is supported by print-outs of the websites of several of the listed providers advertising “hop-on hop-off” bus tours across London.

27. In support of its assertion that ‘hop-on-hop-off’ is a generic term, the applicant draws my attention to popular tourist website TripAdvisor, which has a designated ‘hop-on-hop-off’ subcategory under its ‘Tours’ section. An undated print-out from the site itself¹³ is provided at Exhibit AF5. It shows that there are 21 tours available in London. Whilst all are described as ‘hop-on hop-off’, not all relate specifically to bus tours; some refer to walking tours and other to river cruises, for example.

28. At Exhibit AF6, the applicant encloses a graph showing indexed online search traffic, provided by Google Trends, for the period 18 August 2013 to 12 August 2018. It illustrates a marked increase in users searching for the term “hop on hop off” within this time. The graph provided is reproduced below:



29. The applicant’s final exhibit, AF7, comprises a selection of ten photographs of buses representing various UK tour operators offering a ‘hop-on hop-off’ facility. Examples of the photographs are displayed below. The applicant maintains that, collectively, the images illustrate the number of operators using the term ‘hop-on hop-off’ in a manner which allows consumers to differentiate between each provider. It is therefore clear, it states, that any protection given to a ‘hop-on-hop-off’ type of mark must be narrow and limited to the design of the logo, not the term in and of itself.

¹³ http://www.tripadvisor.co.uk/Attractions-g186338-Activities-c42-t229-London_England.html



City Sightseeing London



DoDublin Hop on Hop off



Sightseeing Manchester



Tour Lincoln

30. That concludes my summary of the evidence, insofar as I consider it necessary.

Proof of use

31. The first issue is to establish whether, or to what extent, the opponent has shown genuine use of the services relied upon. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or

(ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain,

and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services”.

32. Section 100 of the Act also applies, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

33. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch); [2013] F.S.R. 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G&D Restaurant Associates Ltd (SANT AMBROEUS Trade Mark)* [2010] R.P.C. 28 at [42] of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV (C-40/01)* [EU:C:2003:145]; [2003] E.T.M.R. 85 , *La Mer Technology Inc v Laboratories Goemar SA (C-259/02)* [EU:C:2004:50]; [2004] E.T.M.R. 47 and *Silberquelle GmbH v Maselli-Strickmode GmbH (C495/07)*[EU:C:2009:10]; [2009] E.T.M.R.28 (to which I added references to *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-416/04 P)* [EU:C:2006:310]). I also referred at [52] to the judgment of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV(C149/11)* EU:C:2012:816; [2013] E.T.M.R. 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-141/13 P)* EU:C:2014:2089 and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd (O/528/15)* [2016] E.T.M.R. 8.

218. [...]

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein RadetskyOrder v*

Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including:

(a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

34. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence

required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

35. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor

is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

36. As the opponent’s earlier mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are also relevant. The court noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

and

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

and

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the

circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

37. In *London Taxi*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

38. The General Court (“GC”) restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

39. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the services at issue in the Union during the relevant five year period. Considerations include:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and/or services for which use has been shown
- iv) The nature of those goods and/or services and the market(s) for them
- iv) The geographical extent of the use shown

Genuine use

40. In its submissions, the applicant commented on the limited time period for which evidence of use has been filed, claiming that the it relates only to limited dates in 2016/17¹⁴. Still, the opponent has clearly filed evidence of use *during* the relevant period. The *Grupo Julià* articles reveal that the opponent achieved notable success in tour operating at the close of 2015 and 2016. The opponent’s statement also indicates that significant expenditure was made towards the marketing and advertising of its London tours during this time, exceeding £150,000 in 2016 and £220,000 in 2017. Furthermore, the combination of the mark’s online presence and the supporting articles illustrate that the opponent has sought to maintain its share in the market and

¹⁴ See paragraph 12 of the applicant’s submissions headed ‘observations in reply’

direct custom from multiple member states. Whilst I agree that the opponent's evidence does not span the entire relevant period, taken as a whole I am satisfied that it relates to a significant proportion of it. The use conditions laid out in section 6A provide no indication, nor does the supporting case law, that there exists a minimum duration, within the relevant period, throughout which proof of use must be satisfied. The frequency or scale of use is but one of the considerations in a multifactorial assessment.

41. I acknowledge that the opponent's evidence relies fairly heavily on the activities of the opponent's subsidiary company, LCTL, whose services are limited to the UK (specifically London). However, use in only one member state can be sufficient to show genuine use¹⁵. That being so, I find the turnover figures provided in respect of LCTL to be significant and am satisfied that the earlier mark has been sufficiently utilised by this subsidiary during the relevant period. Even in the absence of an indication as to the extent of sales *directly* attributable to the opponent's earlier mark, I consider turnover figures in excess of £2m (in respect of relevant services), even in a market of considerable value, enough to establish sufficiency of sales for the purpose of a genuine use assessment. Whilst such an indication would have been useful, I am satisfied, based on the evidence as a whole, that a significant proportion of the sales figures is likely to relate to the services in respect of which use of the mark has been shown. Precisely which services these are is a matter which must be determined.

42. If my conclusion regarding the sufficiency of the opponent's evidence is incorrect (insofar as use of the mark as registered is concerned), the opponent has also shown use of the variant mark shown below:



¹⁵ TVR Automotive Ltd

43. The opponent argues that as the word 'ALLIANCE' is smaller and of less importance than the mark's remaining elements, the above variance constitutes use of the earlier mark. The applicant, in contrast, argues that as 'ALLIANCE' shares equal prominence with the words 'hop on hop off', the opponent's removal of the word 'ALLIANCE' must alter the distinctive character of the earlier mark and is consequently not an acceptable variant.

44. Section 46(2) of the Act provides for use of trade marks in a form differing in elements which do not alter the distinctive character of the mark as registered. In *Nirvana Trade Mark*, Case BL O/262/06, Richard Arnold Q.C. (as he then was), as the Appointed Person, considered the law in relation to the use of marks in different forms and summarised the s.46(2) test as follows:

"33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

45. In light of the above case law, I must determine whether the distinctive character of the earlier mark is altered by the removal of 'ALLIANCE'. Use of a mark with matter either added or subtracted is acceptable providing that the registered mark maintains its distinctive character and continues to fulfil its function of indicating the origin of the goods or services¹⁶. 'Alliance' often refers to a union or association and, in my

¹⁶ *Colloseum Holdings AG v Levi Strauss & Co*, C-12/12, paragraphs 31-35

experience, its use within a company moniker is not particularly uncommon; comparable to 'Ltd' or '& Co', for example. Consequently, it is unlikely to hold any independent significance in the context of the mark in the eyes of the average consumer. The manner in which it is presented (on a yellow banner), whilst in keeping with the mark's other elements, is not particularly distinctive. On that basis, the mark's distinctiveness is likely to be defined predominantly (though not necessarily equally) by its 'hop on/hop off' element and adopted stylisation, both of which appear, as registered, in the variant mark. Consumers familiar with the earlier mark (in its entirety) are, in my view, likely to recognise the variant as an amended mark originating from the same undertaking. I do not agree with the applicant's assertion that the distinctive character of the opponent's mark is altered by the removal of the word 'ALLIANCE' and therefore find the reduced mark to be an acceptable variant. Though some of the exhibits displaying the variant mark are undated, they make a relevant contribution to my considerations of the evidence and conclusion as to the evidence's sufficiency.

Fair specification

46. In terms of devising a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Geoffrey Hobbs Q.C., as the Appointed Person, summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned".

47. Carr J summed up the relevant law in regard to fair specifications in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch). This was a revocation case, but the same principles apply in an opposition:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].”

48. The opponent has shown use of its mark in respect of the arrangement and operation of sightseeing tours, in addition to which, the evidence indicates, it provides supplementary tourist information by way of on-board brochures and audio guides. When considered alongside the relevant case law, the evidence leads me to conclude that a fair specification for the opponent would read as follows:

Transportation of passengers; Booking of seats for travel; Travel arrangement; Tour operating; Sightseeing services; Escorting of travellers; Advice on tourist visits.

49. Whilst I appreciate that the opponent has retained terms which, at first glance, appear relatively broad, I find that the operational activities provided by the opponent, as shown in its evidence, are wholly embedded within the retained services, keeping in mind their core meanings and how such activities would be described by the average consumer. The above, therefore, represents the services which the opponent may rely upon for the purpose of the opposition and is neither too broad nor too pernicky.

Section 5(2)(b) - Case law

50. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

51. The competing services, all proper to class 39, are as follows:

Opponent's services	Applicant's services
Transportation of passengers; Booking of seats for travel; Travel arrangement; Tour operating; Sightseeing services; Escorting of travellers; Advice on tourist visits	Provision of bus tours; sightseeing services; provision and arranging of tours; provision of tourist information and advisory services relating to travel and sightseeing; rental of buses, including for film shoots and promotional videos.

52. In paragraph 6 of its statement of grounds, the opponent submits that:

“The services covered by the Subject Mark are identical, or at least highly similar, to those covered under the Opponent’s Mark. For example, the service “provision of bus tours” is wholly contained within the opponent’s services “transportation of passengers” and “tour operating” and therefore identical. Services relating to sightseeing, travel, provision of tourist information, and bus rental are also identical or at least highly similar to the opponent’s services.”

53. In its counterstatement, the applicant’s response reads as follows:

“6. Admitted, subject to the Opponent’s proof of use.”

54. Even in light of the recent determination of a fair specification for the opponent, the parties clearly agree that the respective services generally share at least a high degree of similarity.

55. The following services are present in both the applicant’s and the opponent’s specification and are, therefore, self-evidently identical:

Sightseeing services

56. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

Though strictly relating to goods, the principle can also be applied to the comparison of services. On that basis, I make the following assessments:

- *Provision of bus tours and provision and arranging of tours* in the applicant's specification are incorporated by the opponent's *tour operating*. The services are, therefore, identical.
- The opponent's *advice on tourist visits* is encompassed by the applicant's *provision of tourist information and advisory services relating to travel and sightseeing*. The services are identical.

57. All that remains within the applicant's specification is *rental of buses, including for film shoots and promotional videos*. When assessing similarity, I am guided by the relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, which were as follows:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

Rental of buses, including for film shoots and promotional videos

58. Whilst the applicant accepted that there is at least a high degree of similarity between the respective services (paragraphs 60 and 61 refer), it is not clear specifically which of the opponent's services it had in mind. Given that the opponent's specification has since been narrowed, I will make a separate assessment based on the factors outlined in *Treat*. Though not strictly identical, there is a chance that the competing services could coincide; 'travel arrangement' and 'tour operating', for example, could rely upon the rental of various vehicles, including buses. Both travel arrangement and tour operating services may be utilised by individuals or businesses. Whilst the same can be said of bus rental, this is more likely to be used by businesses looking to cater for larger groups. When it comes to the respective trade channels, to my knowledge, both services depend fairly significantly on the custom generated by their online presence. Whilst not necessarily complementary, it would not be unreasonable for consumers to expect an undertaking to offer vehicle rental and travel arrangement, for example, simultaneously. Furthermore, as I have already suggested, tour operation may rely on the rental of vehicles, including buses, for the provision of such services. The services may also be considered competitive, insofar as their classification is concerned, as they may be placed in the same sectors, or sector, of industry. Of course, as apparent in the wording of the applicant's service, bus rental is not exclusively provided for travel purposes. Where the rental is selected for film shoots and promotional videos, for example, there is a marked distinction between the competing services. All things considered, I find there is at least a medium degree of similarity between the services.

The average consumer and the nature of the purchasing act

59. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

60. The average consumer for the services at issue is likely to be a member of the general public, particularly tourists or at least those with a need or desire to travel for personal or business use, with the services often selected on a visual basis from the pages of the relevant website or brochure, for example. I keep in mind, however, that oral recommendations are not uncommon in the tourist industry and that customers may be able to order said services over the telephone. Consequently, aural considerations cannot be ignored. The services are available in a variety of prices and will be purchased fairly infrequently. When making their selection, consumers are likely to consider factors such as the content and duration of the specific service and the reputation of the respective provider. All things considered, I find it likely that they will apply a reasonable degree of attention to the purchasing process to ensure the service meets their specific requirements.




Comparison of trade marks

61. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. ...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

62. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

63. The trade marks to be compared are displayed in the table below.

Opponent’s trade mark	Applicant’s trade marks
	<p data-bbox="890 1473 1134 1509"><u>UKTM 3266023:</u></p>   <p data-bbox="919 1995 1107 2027">(SERIES OF TWO)</p>

	<u>UKTM 3266031:</u> HOP-ON DISCOVER HOP-OFF EXPLORE
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64. The opponent's mark comprises a figurative representation of the words 'hop on hop off ALLIANCE'. Structurally, the words 'hop on' sit above the words 'hop off'. Both are positioned to the left of 'ALLIANCE' and all words within the mark navigate slightly upwards on the right. In the absence of any spacing or punctuation, in each case the word 'hop' can be distinguished from the word it precedes by the variation in colour; in each case the word 'hop' is presented in white and the word which immediately follows, namely on/off, is presented in black. 'Hop on' and 'hop off' are presented in lower case in a font with rounded edges adorned by bright yellow borders. To emphasise the adopted effect, a black outline creating the impression of a shadow emerges underneath both silhouettes, making the phrases appear more 3-dimensional. Returning briefly to the yellow borders, the first reaches a pointed peak immediately before the initial 'h' (of hop on) and the second immediately after the final 'f' (of hop off), evoking an impression of small arrowheads pointing in alternate directions; one left and one right. 'ALLIANCE' is positioned independently, presented in a standard black font in upper case, atop a mostly rectangular banner in the same shade of yellow as the borders used for 'hop on' and 'hop off'. The continuation of colour (from 'hop off') is interrupted by what appears to be a white chevron, the banner beginning with an inverted peak. Whilst the overall impression of the mark lies in the unit created by its combined elements, I find it likely that, given the nature and positioning of the word 'ALLIANCE', its 'hop on hop off' component will play a greater role, with both the word and stylistic elements of which it is comprised making a contribution.

65. The first of the applicant's marks in its series of two (UKTM 3266023) is presented in colour, with each of its elements sitting atop a rectangular burgundy background. At the centre of the mark is the upper case text 'HOP ON + OFF'. 'HOP' is presented in a larger font than the remaining words, which occupy a second line of text underneath. Both lines of text appear in white in a fairly standard bold font, with rounded edges to its letters. Arrows spanning 90 degree angles straddle the bottom left and top right hand corners of the mark, creating an almost entirely unbroken border

around the text. The head of the left hand arrow, which is yellow in colour, sits in the top left corner pointing upwards and the right hand arrow, presented in white, reaches its peak in the bottom right corner, pointing downwards. The second mark in the series is a grayscale version of the first mark. The stylisation is effective and, in my view, makes a roughly equal contribution to the text in regard to the marks' overall impression.

66. The applicant's second mark, UKTM 3266031, consists solely of the words 'HOP-ON DISCOVER HOP-OFF EXPLORE', presented in upper case. In my view, the natural rhythm of the mark encourages it to be seen as something of a unit. Given the services for which registration is sought, none of the words, individually, are likely to be seen as the most dominant. Discovery and exploration are themes often associated with travel and tourism services and 'hop-on' and 'hop-off' seem to provide some insight into the method of travel. The mark's overall impression lies in its totality.

Visual comparison

67. Beginning with the applicant's series marks, there is a clear visual similarity with the opponent's mark in the coincidence of word elements 'HOP', 'ON' and 'OFF', albeit presented in different cases. In the case of the applicant's colour mark, there is also an overlap in some selected colours and imagery, with white text and yellow representations of arrows, or at least arrowheads, featuring in both, though I appreciate there is a fairly wide discrepancy in the respective representations, which will not go unnoticed. This is where the similarities cease. The structure of the marks is markedly dissimilar, as are the additional stylistic embellishments. The opponent's mark comprises a duplicated 'hop' and an additional word in ALLIANCE and the applicant's a 'plus' symbol and burgundy background, none of which have counterparts in the competing marks. Whilst slightly higher in the case of the applicant's colour mark on account of the shared yellow and white elements, on balance, I consider there to be no more than a low to medium degree of visual similarity between the competing marks.

68. The only visual similarity I can identify between the applicant's mark ending '031 and the opponent's mark is the presence of the words 'hop' (duplicated in each), 'on'

and 'off'. There are clear visual differences in the number of words each mark comprises, the applicant's mark incorporating 'DISCOVER' and 'EXPLORE' and being notably longer, and in their aesthetic makeup, with the applicant's mark void of any stylisation in stark contrast to the opponent's. That being so, I keep in mind that fair and notional use of the applicant's mark would allow its presentation in similar colours to those adopted in the opponent's mark and in a font with rounded edges. All things considered, I find the visual similarity to be of a low degree.

Aural comparison

69. The opponent's mark, when articulated in its entirety, comprises seven syllables; HOP-ON-HOP-OFF-ALL-I-ANCE. Given the nature of 'ALLIANCE', to which I have already referred, I find it unlikely that the average consumer will, at least with any degree of consistency, choose to articulate it. It is more likely, in my view, that consumers will reduce the mark to simply HOP-ON-HOP-OFF. As consumers are likely to recognise the plus symbol (+) as an alternative to the word 'and', the applicant's series marks are likely to be articulated in a total of four syllables, namely HOP-ON-AND-OFF, three of which are identical to those in the opponent's mark and presented in the same order. This results in what I consider to be a fairly high degree of aural similarity.

70. Given that it is likely to be viewed as a unit, the applicant's word-only mark will, in my opinion, be articulated in nine syllables, specifically HOP-ON-DIS-CO-VER-HOP-OFF-EX-PLORE. The four syllables by which the opponent's mark is likely to be articulated are repeated in full within the applicant's mark and in the same order. Whilst 'hop on' and hop off' remain together, an aural distinction is created by the interruption of additional syllables DIS-CO-VER and EX-PLORE. On balance, I find the aural similarity to be of no more than a medium degree.

Conceptual comparison

71. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and

the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

72. Based on my own experience, I find it unlikely that consumers will attach any specific conceptual significance to the final word in the opponent's mark, 'ALLIANCE', recognising it purely as an indication of a company or working group. I also find it unlikely that consumers will see any tangible conceptual message in the adopted stylisation, though I accept the representations of arrows may be vaguely indicative of travel services. Consequently, consumers are likely to seek conceptual clarification predominantly, if not solely, in the term 'hop on hop off'. In my experience, the average consumer will have an understanding of its meaning, which, in general terms, refers to a mode of transport that travellers can depart and re-board at their leisure, usually for the purchase of a single ticket. When it comes to the applicant's series marks, consumers are likely to look to 'HOP ON + OFF' for a conceptual indication, assigning little weight to the background or surrounding arrows, which support the concept of transport travelling either back and forth or in a circuit. Consequently, in my view, a highly similar (if not identical) concept will be evoked.

73. The ability to flexibly re-board the relevant transport remains a concept in the applicant's word-only mark (on account of it incorporating 'hop-on' and 'hop-off'). The additional words 'DISCOVERY' and 'EXPLORE' seem to paint a broader picture alluding to a sense of adventure or new surroundings. 'Hop on, hop off', in isolation, is indicative of flexibility, and the marks have this in common, but alone it is not necessarily suggestive of a wider scale of travel; more so an indication of a flexible transport facility. The applicant's mark explicitly introduces a reason to 'hop on' or 'hop off', i.e. specifically to explore or discover. However, given that transport facilities of this nature are often associated with sightseeing services, rather than what could be described as 'every-day' travel, for the average consumer, the additional concepts introduced in the applicant's word-only mark are likely to be inherently implied in the opponent's mark. Consequently, I find the conceptual similarity to be of at least a high degree.

Distinctive character of the earlier trade mark

74. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

75. Whilst the opponent has not claimed that the distinctive character of its earlier mark has been enhanced through use, it has filed evidence in support of its use. Although I have found the exhibits sufficient for the purpose of demonstrating use, the opponent has not provided the additional context required to make a finding of enhanced distinctiveness; the market value and its share, for example. Consequently, an assessment must be made purely on the basis of the mark’s inherent distinctiveness.

76. It is widely accepted, though only a guideline, that words which are invented often possess the highest degree of distinctive character, whilst words which are suggestive or allusive of the goods and/or services relied upon generally possess the lowest.

77. When considering the earlier mark's inherent distinctiveness, I bear in mind the parties' comments regarding the term 'hop on/hop off'. In its counterstatement(s), the applicant states:

"5. ...the phrase HOP ON HOP OFF is in widespread and common use in the sightseeing tour bus market in question. It follows... that the scope of protection afforded to that phrase should be minimal (at best)".

The opponent makes the following submission:

"Whilst this term may not be highly distinctive, one does not readily refer to 'hop' in respect of getting on or off a form of transport... As such, 'hop' becomes more unusual in nature."

78. I disagree with the opponent's claim. In my experience, and as shown in the applicant's evidence, especially when considered in relation to the services for which it is registered, the use of 'hop on, hop off' is fairly common and is descriptive of a characteristic of a transport or travel service, signalling to consumers that they are able to re-board at their own convenience. I find it likely that the average consumer will be equally familiar with the term and interpret it in the same way, particularly in light of the applicant's evidence which wholly supports such a finding. I keep in mind the judgment of the CJEU in *Formula One Licensing BV v OHIM*¹⁷ which indicates that a registered trade mark must be considered to have at least a minimum degree of distinctive character. Based on my findings thus far, I reach the view that the word elements of the mark are lowly distinctive. However, the mark is not solely comprised of elements which are descriptive or allusive; its stylisation is not negligible and plays a key role in the mark's overall impression. All things considered, I find the mark's inherent distinctiveness to be fairly low.

¹⁷ Case C-196/11P

Likelihood of confusion

79. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

80. Earlier in this decision I reached the following conclusions:

- Some of the competing goods are identical; some are similar to a fairly high degree;
- The average consumer is a member of the general public, particularly tourists or businesses;
- Visual considerations are likely to dominate the selection process, though aural considerations are also relevant;
- A reasonable degree of attention is likely to be paid to the selection of goods;
- In the case of the applicant's series marks, the competing marks are visually similar to a low to medium degree, aurally similar to a fairly high degree and conceptually similar to at least a high degree (if not identical);
- In the case of the applicant's word-only mark, the competing marks are visually similar to a low degree, aurally similar to no more than a medium degree and conceptually similar to at least a high degree;
- The opponent's trade mark possesses a fairly low degree of inherent distinctiveness.

81. When considering the impact of distinctive character, I keep in mind *L'Oréal SA v OHIM*, Case C-235/05 P, where the CJEU found that:

"45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of

the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

82. The opponent refers me to *BSH Bosch und Siemens Hausgeräte GmbH v EUIPO and LG Electronics Inc.*¹⁸, in which the first-named party had filed an application to register the mark shown below as an EU trade mark in relation to goods in classes 7, 9 and 11.



83. The application was opposed by LG Electronics Inc. on the basis of an earlier mark comprised of the word KOMPRESSOR. Insofar as the respective goods were the same or similar, the EUIPO upheld the opposition. Appeals to the Board of Appeal and the General Court were rejected. A further appeal was made to the CJEU. One of the grounds for appeal was that insufficient weight had been given to the fact that the word COMPRESSOR was descriptive for certain categories of relevant goods; namely, those that included a compressor. The appeal was heard by the Grand Chamber of the CJEU.

¹⁸ Case C-43/15P

84. The presiding judgement of the CJEU confirmed pre-existing CJEU case law to the effect that the level of distinctive character of an element which is common to both marks (or similar as between them) is but one element in the global assessment of the likelihood of confusion. Consequently, even where the level of distinctive character of the element in question is very low, other factors in the required global assessment, such as the identity of the goods/services and a high level of overall similarity between the marks, may still justify a finding that there is a likelihood of confusion.

85. Shortly after the CJEU's judgment in the *Kompressor* case, judgement was given in a UK trade mark appeal to the High Court in England and Wales: *Nicoventures Holdings Limited v The London Vape Company Ltd*¹⁹. An application had been made to register the mark shown below in relation to electronic cigarettes.



86. It was opposed on the basis of the following earlier mark, which was registered for the same goods.



87. The registrar upheld the opposition, finding that the marks were highly similar and the goods identical. In these circumstances, the low distinctiveness of the elements VAPE and CO was found to be insufficient to avoid a likelihood of confusion. However, the appeal to the High Court was upheld²⁰. The judge explained that the nature of the marks' common elements needed to be considered and that, where the common elements are found to be descriptive and non-distinctive, it is necessary to focus on the impact this has on the likelihood of confusion. Whilst it does not preclude such a likelihood, it does weigh against it. The judge instructed that the matter be reconsidered bearing in mind the *White and Mackay* principle.

¹⁹ [2017] EWHC 3393 (Ch)

²⁰ EWHC 3393 (Ch)

88. The *Whyte and MacKay* principle referred to is a reference to an earlier judgment of the High Court in England and Wales²¹, in which another judge concluded that:

“...what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

89. Neither of the judgments of the High Court go quite so far as to exclude the likelihood of confusion where the only element in common between two marks is one that lacks distinctive character. They are therefore consistent with *Kompressor* and the case law of the CJEU which precedes it. That will remain the case unless or until the so-called *Whyte and MacKay* principle is elevated to a rule that a likelihood of confusion cannot be based on non-distinctive similarities between marks.

90. To make the assessment as to a likelihood of confusion, I must adopt the global approach advocated by the case law and take account of my earlier conclusions. I keep in mind the average consumer for the services at issue, the nature of the purchasing process and the fact that the average consumer rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them retained in their mind.

91. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the marks and goods and/or services down to the responsible undertakings being the same or related.

92. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are

²¹ [2015] EWHC 1271 (Ch)

very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.””

93. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C., as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. Simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’. It is the common element which is key to my assessment.

94. The primary element which is common to each of the competing marks is the reference to ‘hopping on and off’ which, when considered in the context of the relevant services, I have found to be low in inherent distinctiveness, insofar as the words themselves are concerned. As the average consumer is likely to recognise the non-distinctive nature of the term, in my view, it will be inclined to attribute the shared reference to a coincidental use of descriptive language, rather than a shared economic undertaking. In other words, it would not be surprised to learn that multiple traders within the sightseeing or travel industry are interested in using ‘hop on/hop off’ as part of their trade mark(s). Consequently, consumers may be encouraged to rely more heavily on the remaining elements of the respective marks in order to determine their origin. With this in mind, and given that the purchase will be made predominantly on a visual basis and that a reasonable level of attention will be paid, I do not consider the stylistic similarities in the respective marks sufficient to give rise to a likelihood of direct confusion. Whilst I acknowledge, in the case of the applicant’s series marks that there is an overlap in colour choices and representations of arrows, the visual similarity, as

a whole, is not of a high degree, but a degree between low and medium. Turning to consider indirect confusion, the variation in stylistic representations and wording throughout the competing marks is, in my view, highly unlikely to be viewed as a natural evolution attributable to a marketing strategy or brand evolution. There will be no confusion.

Conclusion

95. Subject to any successful appeal, the application will proceed to registration.

Costs

96. As the applicant has been successful, it is entitled to a contribution toward its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the applicant on the following basis:

Reviewing the Notice of Opposition and preparing a counterstatement:	£200
Preparing evidence and considering the other side’s evidence:	£600
Total:	£800

97. I order JULIA TRAVEL, S.L. to pay Big Bus Tours Limited the sum of £800. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

13th of February 2019

**Laura Stephens
For the Registrar**